APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/091,735	06/24/98	BRAMHILL I	36-1230

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EXAMINER
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ART UNIT	PAPER NUMBER
2764	4

DATE MAILED: 12/22/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/091,735	Applicant(s) Bramhill et al.
	Examiner Cuong H. Nguyen	Group Art Unit 2764

☒ Responsive to communication(s) filed on _the priority paper (PCT/DO/EO/903) received on 09/07/1999._

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters,   **prosecution as to the merits is closed** in accordance with the practice under _Ex parte Quayle_, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____3___ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) _1-27_____ is/are pending in the applicat

  Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) _1-27_____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

  ☒ All ☐ Some* ☒ None   of the CERTIFIED copies of the priority documents have been

    ☒ received.

    ☐ received in Application No. (Series Code/Serial Number) _____ .

    ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

  *Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

1.   This Office Action is the answer to the communication received on 09/07/99 (PCT/DO/EO/903).

2.   Claims **1-27** are pending in this application.

Drawings

3.   This application has been filed with 8 sheets of formal drawings which are acceptable by the draftsman.

The following rejections are based on the examiner's best interpretation of the claims.

4.   *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **19-21, 27** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

As per claim **19**: "A server configured to perform a method as claimed in claim 1".

As per claim **20**: "Initiation by the client, of the downloading of copy protected data by a method according to claim 1".

As per claim **21**: "A copy protected data stored on the client by a method according to claim 1".

As per claim **27**: "A client configured to perform a method as claimed in claim 22".

These above claims are unclear and do not adequately define the technical features of the subject matter to be protected, such that no meaningful opinion can be formed on the non-obviousness of the claimed subject matter. A claim may contain a reference to another claim even if it is not a dependent claim as defined in 35 U.S.C. rules. One example of this is a claim referring to a claim of a different category (e.g., "Apparatus for carrying out the process of Claim 1...", or "Process for the manufacture of the product of Claim 1..."). In such case it should be clear <u>to which extent the</u> claim containing the reference necessarily <u>involves all the features of the claim referred to and to which extent it does not</u>. In general, the fact that the claim referred to contains novel and inventive matter does not necessarily imply that the same is also true of the independent claim containing the reference. Moreover, although the respective category of claim 19 is partially not clear, it is held that the present formulation of this claim does not precisely define limitations of the claimed server, initiation, copy protected data and client, respectively, because it contains solely a vague reference to the method claims. For

example, Claim 19 ("server configured to perform a method...")

must be understood as covering in effect any server computer

suitable for performing the method, which is not a sufficient

definition.

As to claim 20, it is not clear whether that claim

("Initiation...") is directed to a "Method for downloading by the

client ..." in which case claim 20 is redundant with claims 22-

26, or

- to the "Use of the client", in that case it is noted that

the client itself is not defined by any explicit features, but

only by reference to the method claim; the "reference of

reference" renders the subject matter of claim 20 unclear.

Claim 19 is not clear, because the mere formulation

"configured to perform a method as claimed ..." does not suffice

to define which technical features must be provided to enable the

server/client to perform the respective method.

Claim 21 is not clear, because its introductory statement is

directed to "copy protected data", which amounts to claim

protection for the content of information rather than for the

physical entity (server, client) or the activity (method of copy

protecting or of downloading copy-protected data) specially

disclosed in the description.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms

the basis for all obviousness rejections set forth in this Office

action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior. art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

Claims 1-27 are rejected under 35 U.S.C. §103(a) as being

unpatentable over Yourdon, in view of Dean et al., Wobber et al.

(U.S. Pat.5,235,642), and further in view of Richardson (PCT WO-

A-9407204).

Yourdon suggests ideas of dealing about security on the

Internet (see Yourdon pg. 28, cols.1-2 about **Security**), he

submits that applications should ensure "secure access to

functionality and data, as well as secure transmission of data

across the Internet". Adding digital signatures to applets is

contemplated, such that a user can be sure of the source and

origin of a downloaded applets. As typical for a client server

application, a password may be asked "to determine the end user's

authorization to invoke certain functionalities of access certain

data", and "the application will interact with the browser to

encrypt/decrypt transmissions between the client and the server".

He further proposes to integrate encryption packages like PGP

into Internet applications and achieve higher security with a

public key password system.

Dean et al. contribute ideas about security issues raised in

Web browsers such as HotJava and Netscape by server supplied code

constituted by Java applets downloaded to and run inside the Web

browsers. "In Netscape, Java applets can name only those

functions and variables explicitly exported to the Java

subsystem". They further suggest that Java would be more secure

if encryption was used.

Both Yourdon and Dean et al. talk about encryption, and

hashing is known in the art as a similar security measure

ensuring integrity of data. Yourdon also suggests hashing by

proposing to add signatures to information downloaded from the

Web such that the receiving side can be sure of its source and

origin, thus of its integrity.

Both Yourdon and Dean et al. suggests method and systems for

ensuring security of functionality and data in a client-server

environment - in particular the Internet. However they do not

directly address the specific problem of protecting from copying

data, & authentication which have been downloaded from a server

to a client, nor its solution as in claim 1.

Wobber et al. proposes to achieve access control using

copies of clients credentials cached at the server for future

use. The security system includes a computer at each node of the

distributed system with a trusted computing base that includes an
authentication agent for authenticating requests received from
principals at other nodes in the system.   Requests are
transmitted to servers as messages that include a first
identifier (i.e. Auth ID) provided by the requester and a second
identifier (called the subchannel value) provided by the
requester and a second identifier (called the subchannel value)
provided by the authentication agent of the requester node.   Each
server process has an associated local cache that identifies
requesters whose previous request messages have been
authenticated.   When a request is received, the server checks the
request's two identifiers against the entries in its local cache.
If there is a match, the request is known to be authentic without
having to obtain authentication from the requester's node.

Nevertheless, it is held that one with skills in the art
would need no inventive activity to infer from the general
teachings of Yourdon ("to determine the end user's authorization
to invoke certain functionalities of access certain data", and
Dean et al. ("applets can name only those functions and variables
explicitly exported to the Java sub-system", at least when taken
in combination, that a solution consists in selectively
controlling copying functions of the client in respect of the
downloaded data, hence arriving at the subject matter of claim 1.

<u>As per claims 5-6, 17</u>:   Yourdon, Richardson, and Wobber et al.

also teaches about password, public key, password system that

claimed (in claims 5, 6, 17).   Therefore, the same reasoning

applies for identifying/authorizing/registering a client to a

server.

<u>As per claims 7-8</u>: Gosling (EP 0718761 A1) also discloses the

downloading of a program. This feature is well-known in the art.

<u>As per claims 9-16</u>: Bender et al. also disclose about

steganographically marking data (claim 16); this feature is also

well-known in the art.   The Official Notice is taken that the

feature of claims 9-13, and the use of a cryptographic key are

well-known in the art.

Conclusion

8.   Claims **1-27** are rejected.

9.   The attached references are considered pertinent to

applicant's disclosure.

10.   Any inquiry concerning this communication or earlier

communications from the examiner should be directed to examiner

Cuong H. Nguyen, whose telephone number is (703)305-4553.   The

examiner can normally be reached on Monday-Friday from 7:00

AM-4:30 PM.

09/091,735
Art Unit 2764

If attempts to reach the examiner by telephone are
unsuccessful, the examiner's supervisor, James P. Trammell, can
be reached on (703)305-9768.

Any response to this action should be mailed to:

Box Issue Fee   Amendments

Commissioner of Patents and Trademarks

c/o Technology Center 2700

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications

intended for entry)

Or:

(703) 305-0040 (for informal or draft communications,

please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal

Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of
this application should be directed to the Group receptionist
whose telephone number is (703)305-3900.

Cuong H. Nguyen
Dec. 17, 1999

James P. Trammell
Supervisory Patent Examiner
Technology Center 2700